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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/656,192   | 09/08/2003  | Mark J. Cooper       | 003659.00029        | 8424             |
| 22907 7590 03/09/2009<br>BANNER & WITCOFF, LTD.<br>1100 13th STREET, N.W.<br>SUITE 1200<br>WASHINGTON, DC 20005-4051 |             |                      |                     |                  |
| EXAMINER   |             |                      |                     |                  |
| LONG, SCOTT  |             |                      |                     |                  |
| ART UNIT   |             | PAPER NUMBER         |                     |                  |
| 1633   |             |                      |                     |                  |
| MAIL DATE  |             | DELIVERY MODE        |                     |                  |
| 03/09/2009   |             | PAPER                |                     |                  |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Advisory Action  
Before the Filing of an Appeal Brief**

**Application No.**

10/656,192

**Applicant(s)**

COOPER ET AL.

**Examiner**

SCOTT LONG

**Art Unit**

1633

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 27 January 2009 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.  
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.  
Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**NOTICE OF APPEAL**

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

**AMENDMENTS**

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☐ They raise the issue of new matter (see NOTE below);  
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.  
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  
The status of the claim(s) is (or will be) as follows:  
Claim(s) allowed: \_\_\_\_\_.  
Claim(s) objected to: \_\_\_\_\_.  
Claim(s) rejected: \_\_\_\_\_.  
Claim(s) withdrawn from consideration: \_\_\_\_\_.

**AFFIDAVIT OR OTHER EVIDENCE**

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

**REQUEST FOR RECONSIDERATION/OTHER**

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:  
See Continuation Sheet.  
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). \_\_\_\_\_  
13. ☐ Other: \_\_\_\_\_.

/Janet L. Epps-Smith/  
Primary Examiner, Art Unit 1633

Continuation of 11, does NOT place the application in condition for allowance because: The applicant has submitted additional arguments and a request for reconsideration. No claim amendments were submitted.

The applicant argues that the instant claims have 4 physical properties: (1) rod-shaped, (2) diameter of 10-20 nm, (3) condensed, and (4) single nucleic acid molecule.

Claim 1 is a product-by-process claim. The composition comprising said complexes "are formed by mixing said nucleic acid molecule and polycation molecules...." Hanson makes DNA/polycation complexes by the same procedure described by instant claim 1. This has been discussed numerous times during the course of prosecution. As previously discussed, this procedure results in complexes having a heterogeneous mixture of shapes. Both the art and the specification confirm this. The applicant has chosen to amend their claims to focus on the structure of a single complex form, even though the applicant and specification acknowledge that there are actually many shapes present in the claimed composition. Since Hanson et al. (US-5844107) practices the process described in claim 1, therefore the product (i.e., rod-shaped, 10-20nm diameter, condensed, single nucleic acid molecule complexes) is inherently produced. The claimed composition is not limited to only rod-shaped condensed nucleic acid complexes, rather the composition COMPRISES rod-shaped condensed complexes, meaning there are many different forms of DNA complexes, including rod-shaped.

Because claim 1 is a product-by-process claim and Hanson et al. teaches this process, the examiner asserts that such a rod-shaped complex is formed. Clearly, the examiner and applicant disagree on Hanson's verification of such a rod-shaped form. If the applicant honestly feels Hanson does not anticipate or is not obvious over the instant claims, the examiner suggests the applicant appeal to the BPAI. The examiner does not find the applicant's arguments persuasive.

Accordingly, the examiner hereby maintains the rejection of the pending claims for the reasons of record and the comments above.

/SDL/ Scott Long  
patent examiner, art unit 1633.